



Attorney ref: ITTD5003ECJP
PATENT

#2

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
OFFICE OF PETITIONS

In Re Application of: RUDOLPH G. BENZ ET AL.

Serial No.: 09/973,907

Filing Date: October 9, 2001

Title: INTENSIFIED HYBRID SOLID-STATE SENSOR

"Express Mail" mailing label # EL888088704 US

Date of Deposit: 12/6/2001

I hereby certify that this paper or fee is being deposited with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and addressed to: Assistant Commissioner for Patents Washington, D.C. 20231

Edward V. Chabano

Attention: Office of Petitions
Box DCA
Assistant Commissioner for Patents
Washington, D.C. 20231

**PETITION TO CORRECT APPLICATION
FILING DATE UNDER 37 CFR § 1.10(d)**

This petition is submitted in response to communications from the U.S. Patent and Trademark Office (PTO), consisting of Applicants' return postcard and the Filing Receipt issued in the subject case (attached as Exhibits 1 and 2, respectively), each of which states the application filing date as is "10/10/01." Applicants filed the present application by Express Mail, deposited with the United States Post Service (USPS) in Durham, North Carolina on October 9, 2001. Based on the facts and evidence provided herein, Applicants submit that the application was duly filed under the provisions of 37 CFR § 1.10(a), and that the stamped receipt date of "10/10/01" is therefore incorrect and according to 37 CFR §10(d), should be changed to reflect the filing date as October 9, 2001.

I. FACTUAL BACKGROUND

The present Petition relates to the filing date accorded to U.S. Patent Application Serial No. 09/973,907. This patent application was mailed on October 9, 2001 using the Express Mail provisions

12/11/2001 09:00:00 03973907

01 FEB 02

130.10 EP

RECEIVED

DEC 11 2001

OFFICE OF PETITIONS

of 37 CFR 1.10(a), and therefore should have been according a filing date as the date on which the application was deposited with the USPS.

On October 9, 2001, the present application was prepared for filing by Maggie Blackman, a paralegal with the firm of Olive and Olive, P.A. which is acting as Applicants' representative. As part of Olive and Olive's normal filing procedures, Ms. Blackman prepared the filing papers, which included the following:

1. a self-addressed postcard bearing an identification of the papers being filed, including the Express Mail number, and a list of the contents in the Express Mail envelope (Exhibit 1);
2. a patent application transmittal letter (Exhibit 3), listing among other things, the inventor names, title of the invention, the Certificate of Mailing with the Express Mail mailing label number printed thereon, and the application filing fee;
3. a check for the appropriate filing fee (Exhibit 4); and
4. a Certificate of Mailing by Express Mail also identifying the papers being mailed, the Express Mail mailing label number, the date the paper was deposited. (Exhibit 5). (Blackman Dec., ¶ 2)

After preparing the application papers, the entire application, including the above noted items were copied for Applicants' file, again in accordance with the firm's filing procedures. Ms. Blackman copied the filing papers at approximately 4:45 pm the afternoon of October 9, 2001 (Blackman Dec., ¶ 3). Rik Owen, the Office Manager of Olive and Olive, witnessed Ms. Blackman making the copies and sealing the Express Mail envelope shortly before 5:00 pm. (Owen Dec. ¶ 2). Ms. Blackman left the office shortly before 5:00 pm on the afternoon of October 9, 2001 to deposit the application papers with the United States Postal Service, whose main Post Office for Durham, North Carolina, and Express Mail drop boxes are located only a few blocks from the offices of Applicants' counsel. (Owen Dec. ¶ 3; Blackman Dec., ¶ 5).

Ms. Blackman proceeded directly to the main U.S. Post Office located on West Chapel Hill Street, Durham, NC, arriving shortly after 5:00 pm on October 9, 2001. (Blackman Dec., ¶ 5). Because the Post Office locks its doors at 5:00 pm, Ms. Blackman proceeded to an Express Mail drop box located adjacent to the Post Office on Rigsbee Avenue in Durham. Ms. Blackman deposited the Express Mail envelope in this drop box at approximately 5:15 pm. (Blackman Dec., ¶ 6). The final pick-up at this particular drop box was posted on the box as scheduled for 5:30 pm (Blackman Dec., ¶ 6). Applicants' representative has frequently used this drop box in the past, and Express Mail packages

deposited therein at any time prior to 5:30PM have always been received by the PTO on the following business day and stamped with a filing date matching the deposit date. (Blackman Dec., ¶ 7, Alexander Dec. ¶ 2).

On October 12th or 15th, 2001, Applicants' representative received the customer copy of the Express Mail Label that had been returned by the Post Office. Unfortunately, the copy of the receipt that was made and retained by Applicants' counsel is virtually unreadable. However, critical information sufficient to confirm that Applicant correctly recorded the Express Mail label number is visible, including the Addressee's box, which includes a reference to Applicants' file number for this application, i.e., ITTD5003, and the Express Mail label number on the top of the receipt. This number matches the label number printed on the Certificate of Mailing, the postcard, and the patent transmittal letter.

On October 22, 2001, Applicants' representative received the stamped postcard from the PTO (Exhibit 1). The postcard indicates the date of receipt in the PTO as "10/10/01." (Blackman Dec., ¶ 9). Upon reviewing the Postcard, Applicants' representative began investigating why the wrong filing date was stamped on the postcard.

On November 2, 2001, Ms. Alexander and Ms. Blackman spoke with Mr. Winston Layton of the United States Post Service. Mr. Layton said that according to records available to him, the final time mail from Rigsbee Avenue Express Mail **was picked up** on October 9, 2001 was 5:11 PM. (Blackman Dec., ¶ 8, Alexander Dec. ¶ 3).

The person responsible for supervising pick-up of Express Mail from the Rigsbee Avenue drop box and other locations in Durham, North Carolina is Tony Santitoro. Mr. Santitoro confirms that on October 9, 2001, the last scheduled collection time identified on the Express Mail Box located on Rigsbee Avenue in Durham, North Carolina was 5:30 PM. (Santitoro Dec. ¶ 2). Mr. Santitoro also confirms that on October 9, 2001, last time Express Mail Box was collected from the Rigsbee Avenue Express Mail box was 5:11 PM. (Santitoro Dec. ¶ 3).

Thus, while Applicants' application was timely deposited in an Express Mail Box on October 9, 2001, for next-day delivery to the Patent Office, a premature pickup from that box resulted in delayed transmittal of the application to the Patent Office. Had the pickup occurred at the posted and scheduled time as should have been the case, the Express Mail receipt would have correctly reflected the October 9 date of deposit. Under the circumstances, the receipt was incorrectly dated; but Applicant had fully complied with all requirements for obtaining an October 9 date.

II. REMARKS

The USPTO rules provide for filing papers via Express Mail in order to obtain a date of filing that is the day the materials are deposited, rather than the date received by the patent office. 37 CFR §1.10 states:

(a) Any correspondence received by the Patent and Trademark Office (Office) that was delivered by the "Express Mail Post Office to Addressee" service of the United States Postal Service (USPS) will be considered filed in the Office on the date of deposit with the USPS. The date of deposit with the USPS is shown by the "date-in" on the "Express Mail" mailing label or other official USPS notation. If the USPS deposit date cannot be determined, the correspondence will be accorded the Office receipt date as the filing date.

Under the requirements of this rule, Applicants' representative filed U.S. Patent Application No. 09/973,907 by Express Mail on October 9, 2001. As described above, after receiving the return postcard back, bearing a date-received stamp of October 10, 2001, Applicants representative undertook a detailed review of the events leading up to the deposit of the Express Mail piece at issues. Based on the above-listed facts, Applicants submit that the Express Mail package, containing application Serial No. 09/973,907, was properly deposited with the USPS according to provisions of 37 CFR § 1.10(a), but through reasons beyond the control of Applicants, was not forwarded to the PTO until October 10, 2001.

37 CFR §1.10, also sets out procedures available to applicants when a paper being filed using Express Mail is not received in a manner consistent with the Rule. 37 CFR §1.10(d) states:

Any person filing correspondence under this section that was received by the Office and delivered by the "Express Mail Post Office to Addressee" service of the USPS, who can show that the "date-in" on the "Express Mail" mailing label or other official notation entered by the USPS was incorrectly entered or omitted by the USPS, may petition the Commissioner to accord the correspondence a filing date as of the date the correspondence is shown to have been deposited with the USPS, provided that:

- (1) The petition is filed promptly after the person becomes aware that the Office has accorded, or will accord, a filing date based upon an incorrect entry by the USPS;
- (2) The number of the "Express Mail" mailing label was placed on the paper(s) or fee(s) that constitute the correspondence prior to the original mailing by "Express Mail"; and
- (3) The petition includes a showing which establishes, to the satisfaction of the Commissioner, that the requested filing date was the date the correspondence was deposited in the "Express Mail Post Office to Addressee" service prior to the last scheduled pickup for that day. Any showing pursuant to this paragraph must be corroborated by evidence from the USPS or that came into being after deposit and

within one business day of the deposit of the correspondence in the “Express Mail Post Office to Addressee” service of the USPS.

As described above, Applicants’ representative, according to their usual practice, copied the Express Mail label number “888088151” from the Express Mail receipt (Exhibit 5), on the following items:

1. The return postcard (Exhibit 1);
2. The Application Transmittal Letter (Exhibit 3); and
3. The Certificate of Mailing by “Express Mail” 37 CFR 1.10 (Exhibit 5).

Applicants respectfully submit that this meets the requirements set forth in 37 CFR §1.10(d)(2).

Applicants also submit that the Declarations of its Office personal clearly establish that the Express Mail piece bearing the number “888088151” containing Application Serial No. 09/973,907 was properly deposited in the Rigsbee Avenue Express Mail drop box before 5:30 PM on October 9, 2001, the last scheduled pick up time at that particular box.

The United States Post Office’s representative, Mr. Santitoro, confirms that the last scheduled pickup at the Rigsbee Avenue box on October 9, 2001 was 5:30 PM, but that instead of complying with its posted pickup times, the Post Office on October 9th erroneously picked up the mail prior to the last time posted for the box. Ms. Alexander confirms in her declaration that other pieces of Express Mail dropped in that box on dates other than October 9 but close in time to October 9, 2001 were picked up no earlier than the posted 5:30 PM pickup time; and that Express Mail deposited by the scheduled pickup time was regularly and correctly accorded the correct date of deposit by the Post Office.

Applicants respectfully submit that the documentary evidence and declarations clearly establish that the date the correspondence was deposited in the “Express Mail Post Office to Addressee” service was October 9, 2001, and was prior to 5:30 PM, the last scheduled pickup for that day. Specifically, the evidence submitted herewith clearly establishes that Applicants’ patent application was properly sent to the PTO by Express Mail deposited in the Rigsbee Avenue drop box at about 5:15 PM, fifteen minutes before the last scheduled pickup time of 5:30 PM. The evidence submitted herewith clearly establishes that it was through no fault of Applicants’ representative that the properly deposited Express Mail was incorrectly picked up by the Post Office on the day following the scheduled pickup, and hence was sent to the PTO on October 10, 2001. Applicants also have established that Applicants’ representative had no reason to suspect that the Post Office would fail to comply with its established and posted procedures on the date in question.

The evidence clearly establishes that Applicants' representative fully complied with each and every requirement of 37 CFR §1.10, and Applicants' patent application should be afforded its proper filing date of October 9, 2001.

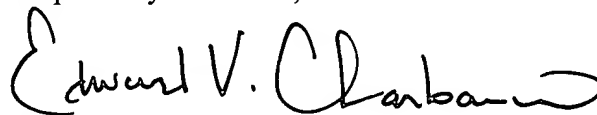
III. CONCLUSION

In view of the foregoing facts and remarks, it is respectfully submitted that Applicants' patent application was properly sent to the PTO using the Express Mail provisions of 37 CFR §1.10(a). Applicants further submit that evidence provided shows the October 11, 2001 receipt date of the application at the PTO was caused by errors on the part of the United States Postal Service. As such Applicants respectfully request that patent application Serial No. 09/973,907 be afforded a filing date of October 9, 2001, the date the application was properly deposited with the USPS.

In addition, Applicants respectfully request that the Filing Receipt mailed on November 11, 2001 be amended to reflect a filing date of October 9, 2001.

December 6, 2001

Respectfully submitted,



Edward V. Charbonneau
Reg. No. 35,478
Attorney for Applicant

Olive & Olive, P.A.
P.O. Box 2049
Durham, NC 27702
(919) 683-5514

RECEIVED
DEC 11 2001
OFFICE OF PETITIONS